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NOV 29 2006

PATENT

Application No. 10/826,929

Attorney Docket No. 57657/04-265

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REMARKS

Claims 1-10 and 12-19 are currently pending in the application. By this amendment, claim 1 is amended. The foregoing separate sheets marked as "Listing of Claims" show all the claims in the application, with an indication of the current status of each.

Claim Rejections: 35 USC § 112, second paragraph

Claims 1-10 and 12-19 stand rejected under 35 USC § 112, second paragraph, as indefinite. This rejection has been addressed by the amendment of claim 1, which applicant submits resolves any potential ambiguities therein.

Claim Rejections: 35 USC § 103

The Examiner has rejected of claims 1, 2, 3, 4, 6, and 7 under 35 USC § 103(a) as obvious over Olsen et al. (hereafter "Olsen") in view of Lai et al. (hereinafter "Lai"). This rejection is traversed.

Initially, the references do not combine to teach all of the claimed elements. The Examiner has noted that the specification defines HA1 as "comprising SEQ ID NO: 1," and interpreted this as meaning that HA1 includes SEQ ID NO: 1, and possibly more. The Examiner then contends that that Lai teaches that "L39914 [is] a fragment or portion of SEQ ID NO: 1." From this the Examiner reaches the conclusion that claim element of "an HA1 protein from which HA2 is absent," is satisfied. Applicant respectfully points out that nothing the Examiner

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has shown provides a teaching of, "an HA1 protein from which HA2 is absent." As the Examiner points out, the word "comprising" is an open form. In the present case however, claim 1 was previously amended to explicitly exclude HA2. Therefore "an HA1 protein from which HA2 is absent," would need to actually be shown in the prior art, rather than relying on language from the specification to infer this limitation from references that do not teach it.

Secondly, even if the references did combine to teach all of the claim elements, there is no motivation to combine these references. The MPEP at §2143.01 states that "[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." On page 5 of the current Office Action, the Examiner states that "Lai et al teaches that the sequences are from equine-2 influenza virus, and ultimately for use in vaccines." Applicant submits that there is no support for this statement in Lai.

The only mention of HA1 sequences in Lai is in the context comparing different equine-2 influenza viruses with one another in order to generate a phylogenetic tree. Claim 1 is directed to a vaccine for equine influenza comprising isolated DNA sequences that encode HA1 protein from which HA2 is absent. There is no suggestion in Lai that an HA1 sequence, in the absence of HA2, could or should be used as DNA in a vaccine. Furthermore, there is no indication that there would be a reasonable expectation of success if the HA1 sequence were so used. The only reference to vaccines in Lai is to the use of whole viruses.

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Therefore, it is clear that no motivation may be found in the references themselves for the combination of Lai and Olsen. Further, as shown, even when combined, the references do not teach all elements of claim 1. For these reasons, the rejection of claim 1 should be withdrawn.

Claims 2-10 and 12-19 depend from and further limit claim 1. Thus, for at least the reasons above, these claims should be allowable over the cited art as well.

Conclusion

In view of the foregoing, it is requested that the application be reconsidered, that claims 1-10 and 12-19 be allowed, and that the application be passed to issue.

Should the Examiner find the application to be other than in condition for allowance, the Examiner is requested to contact the undersigned at 918-599-0621 (fax: 918-583-9659; email: aweeks@fellersnider.com) to discuss any other changes deemed necessary in a telephonic or personal interview.

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A request and payment for a two-month extension of time accompanies this paper. If any additional fees are required, please charge any deficiencies in fees to Attorney's Deposit Account No. 06-0540. Please credit any overpayment of fees to the same account.

Respectfully submitted,



SIGNATURE OF PRACTITIONER

November 29, 2006
DATE

Reg. No.: 36,050

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